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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                  | CONFIRMATION NO.       |
|--|-------------|----------------------|--------------------------------------|------------------------|
| 10/659,581   | 09/09/2003  | William R. Wadleigh  | 1842.002US1                          | 4658                   |
| 70648 7590 09/20/2007<br>SCHWEGMAN, LUNDBERG & WOESSNER/WMS GAMING<br>P.O. BOX 2938<br>MINNEAPOLIS, MN 55402 |             |                      | EXAMINER<br>D'AGOSTINO, PAUL ANTHONY |                        |
|  |             |                      | ART UNIT<br>3714                     | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>09/20/2007              | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/659,581

Applicant(s)

WADLEIGH, WILLIAM R.

Examiner

Paul A. D'Agostino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-18, 20-25, 27-33, 35-39, 41-48 and 50-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-18, 20-25, 27-33, 35-39, 41-48 and 50-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Remarks***

1. This responds to Applicant's Arguments/Remarks dated May 29, 2007.
2. Claims 1, 4, 7, 17, 24, 32, 38, 44 and 47 are amended. Claims 9, 19, 26, 34, 40 and 49 are canceled without prejudice or disclaimer. Claims 1-8, 10-18, 20- 25, 27-33, 35-39, 41-48 and 50-52 are pending.
3. Claim 26 has been cancelled and as such the claim objection is withdrawn.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ

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644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321 (d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48 and 50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,517,433 to Loose (Loose) of record in view of U.S. Patent No. 6,375,570 to Poole (Poole) of record and U.S. Patent No. 6,270,411 to Gura et al. (Gura) of record. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards a gaming system that has a video overlay of the reel symbols that when triggered shows a video presentation overlaying the symbols using a motion like video or animation. Loose teaches all of the claimed invention including an overlay of game symbols that interact with the reel symbols, and the video display is triggered by a bonus condition or type of symbol. Loose does not teach the apparatus on a portable video game system, a personal computer, and a video game system using a television set, and does not fully teach full motion video. Poole teaches of a display overlay over certain symbols resulting from a triggering condition on a portable video game system, a personal

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computer, a video game system using a television set (col. 4, 35-42) and full motion video (col. 2, 15-30) in order to create greater player entertainment and excitement.

It would have been obvious to one of ordinary skill in the art at the time of invention to employ the portable video game system, personal computer, video game system using a television set (col. 4, 35-42) and full motion video as taught by Poole into the invention of Loose in order to create greater player entertainment and excitement.

Loose, as modified by Poole, fails to disclose at least one reel symbol element remaining at least partially visible while a supplemental graphical element is displayed whereby the displaying on the same screen there is an overlaying of the pixel values of the at least one symbol element with pixel values of the supplemental graphical element.

Gura teaches of a gaming machine wherein upon the occurrence of an event, at least one reel symbol element remains at least partially visible while the supplemental graphical element is displayed whereby the displaying on the same screen there is an overlaying of the pixel values of the at least one symbol element with pixel values of the supplemental graphical element (figs. 10-12 and col. 11, 4-33) in order to provide gaming machines with new types of features to satisfy the demands of players and operators (col. 1, 39-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the overlaying display as taught by Gura into the

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teachings of Loose as modified by Poole in order to provide gaming machines with new types of features to satisfy the demands of players and operators.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 10-13, 17-18, 20-25, 27-33, 35-39, 41-48 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,517,433 to Loose of record in view of U.S. Patent No. 6,270,411 to Gura of record.

Regarding claims 1, 4, 7, 17, 24, 32, 38, 44, and 47, Loose discloses a method comprising: displaying a supplemental graphical element over at least one symbol element in one or more displayed reels of a casino gaming machine, wherein the at least one symbol element remains at least partially visible while the supplemental graphical element is displayed. Loose also discloses an apparatus using processors displaying multiple images with a triggering event to display a video event overlaying the elements (col. 2, 25-33, col. 4, 58-67, col. 5, 52-67). However, Loose fails to disclose the displaying including overlaying pixel values of the at least one symbol element with pixel values of a supplemental graphical element.

Gura teaches of a gaming machine wherein upon the occurrence of an event,

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at least one reel symbol element remains at least partially visible while the supplemental graphical element is displayed whereby the displaying on the same screen there is an overlaying of the pixel values of the at least one symbol element with pixel values of the supplemental graphical element (figs. 10-12 and col. 11, 4-33) in order to provide gaming machines with new types of features to satisfy the demands of players and operators (col. 1, 39-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the overlaying display as taught by Gura into the teachings of Loose as modified by Poole in order to provide gaming machines with new types of features to satisfy the demands of players and operators.

Regarding claims 2, 5, and 45, Loose discloses displaying the at least one symbol element; determining, based on the at least one symbol element, whether a triggering event has occurred; and if a triggering event has occurred, identifying the supplemental graphical element as a set of video images (col. 4, 58-67).

Regarding claims 3, 6, 8, 18, 25, 33, 39, 46, and 48, Loose discloses a method wherein displaying the supplemental graphical element comprises displaying the supplemental graphical element in a manner that creates an appearance of full motion video (col. 4, 58-67).

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Regarding claims 10, 11, 20, 21, 27, 28, 35, 36, 41, 42, 50, and 51, Loose discloses an apparatus wherein the one or more processors causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as an opaque and semi transparent overlay over one or more of the multiple game element images (col. 5, 23-30).

Regarding claims 12, 22, 29, 37, 43, and 52, Loose discloses an apparatus wherein the one or more processors further: determines whether a video image is associated with an alteration of a game element image within a game element area; and if the video image is associated with the alteration, causes an altered image to be displayed in the game element area (col. 4, 58-67, col. 5, 1-10).

Regarding claim 23, Loose discloses an apparatus further comprising a money/credit input/output (I/O) device for enabling a player to obtain credits; and player input devices that enable the player to specify a bet and to initiate a spin of the multiple reels (col. 3, 26-41).

Regarding claims 30 and 31, Loose discloses a method wherein the electronic game is a game designed for execution on a wagering game machine, and causing the set of video images to be displayed comprises causing the set of video images to be displayed on a display device coupled to the wagering game machine (col. 1, 40-54).



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8. Claims 1-8, 10-13, 17-18, 20-25, 27-33, 35-39, 41-48 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,375,570 to Poole of record in view of U.S. Patent No. 6,270,411 to Gura of record.

Regarding claims 1, 4, 7, 17, 24, 32, 38, 44, and 47, Poole discloses a method comprising displaying a supplemental graphical element over at least one symbol element in one or more displayed reels of a casino gaming machine, wherein the at least one symbol element remains at least partially visible while the supplemental graphical element is displayed. Poole also discloses an apparatus using processors displaying multiple images with a triggering event to display a video event overlaying the elements (col. 2, 14-30, col. 2, 40-49, col. 4, 25-41).

Regarding claims 2, 5, and 45, Poole discloses a method comprising displaying the at least one symbol element; determining, based on the at least one symbol element, whether a triggering event has occurred; and if a triggering event has occurred, identifying the supplemental graphical element as a set of video images (col. 2, 40-55).

Regarding claims 3, 6, 8, 18, 25, 33, 39, 46, and 48, Poole discloses a method wherein displaying the supplemental graphical element comprises displaying the supplemental graphical element in a manner that creates an appearance of full motion video (col. 2, 17-31).

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Regarding claims 10, 11, 20, 21, 27, 28, 35, 36, 41, 42, 50, and 51, Poole discloses an apparatus wherein the one or more processors causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as an opaque and semi transparent overlay over one or more of the multiple game element images (col. 6, 12-20).

Regarding claims 12, 22, 29, 37, 43, and 52, Poole discloses an apparatus wherein the one or more processors further: determines whether a video image is associated with an alteration of a game element image within a game element area; and if the video image is associated with the alteration, causes an altered image to be displayed in the game element area (col. 7, 30-50).

Regarding claims 13-16, Poole discloses an apparatus wherein the apparatus forms a portion of a wagering game machine, portable battery powered video game system, a personal computer, and a video game system that interacts with a television set; where the apparatus further comprises a display device, operatively coupled to the one or more processors (col. 4, 36-42).

Regarding claim 23, Poole discloses the electronic slot machine further comprising a money/credit input/output (I/O) device for enabling a player to obtain credits; and player input devices that enable the player to specify a bet and to initiate a spin of the multiple reels (col. 4, 46-59, col. 5, 1-9).

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Regarding claims 30 and 31, Poole discloses a method wherein the electronic game is a game designed for execution on a wagering game machine, and causing the set of video images to be displayed comprises causing the set of video images to be displayed on a display device coupled to the wagering game machine (col. 4, 26-41).

### ***Response to Arguments***

9. Applicant's arguments with respect to claims rejected under have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments, see Arguments/Remarks, filed May 29, 2007, with respect to the rejection(s) of claim(s) 1-8, 10-13, 17-18, 20-25, 27-33, 35-39, 41-48 and 50-52 under 35 U.S.C. §§ 102 (b) and (e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 6,270,411 to Gura.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 7,195,559 to Gilmore et al. discloses a slot machine with dynamic wild symbol feature; U.S. 6,554,704 to Nicastro et al. discloses a maze-based game for a gaming machine; and U.S. Patent No. 6,506,114 to Estes et al. discloses an object drop feature for a gaming machine.

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12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

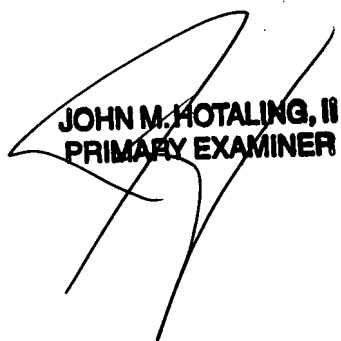
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571) 270-1992. The examiner can be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**JOHN M. HOTALING, II**  
**PRIMARY EXAMINER**

Paul A. D'Agostino  
Examiner  
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